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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) DOW-31481-A	
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>45188</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Alan E. Wagner</u> Typed or printed name <u>Alan E. Wagner</u> Telephone number <u>414-273-2100</u> Date <u>March 13, 2006</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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Patent

Attorney Docket No. DOW-31481-A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Wei-Kuo Lee, et al.
Serial No. : 10/813,367
Filing Date : March 30, 2004
For : CABLE SEMICONDUCTING SHIELD
Group Art Unit : 2831
Examiner : Nguyen, Chau N.
Attorney Docket No.: DOW-31481-A

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

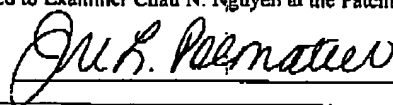
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Date: March 13, 2006



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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

COMMENTS

These comments accompany the Pre-Appeal Brief Request for Review filed concurrently with the Notice of Appeal for this case. The Applicants believe that this case is appropriate for the pilot Pre-Appeal Brief Request because at least some of the arguments against the rejection are based on incomplete disclosure in the prior art and/or legally improper reasoning in the Examiner's proposed *prima facie* case.

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In the Response to the previous Office Action that was mailed May 2, 2005, the Applicants argued that the claims were not obvious due to unexpected results achieved by the claimed composition. In the Response to the Arguments in the Final Rejection, the Examiner stated that "the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious" See *Ex Parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The Applicants believe that the case cited by the Examiner does not support the Examiner's conclusion. In particular, the Board's holding in *Obiaya* rests on two precedent cases, *In Re Best*, 195 USPQ 430 (CCPA 1977) and *In Re Wilder*, 166 USPQ 545 (CCPA 1970).

In Re Best, deals with a 102/103 rejection in view of newly discovered functions or properties inherently possessed by things in the prior art. See page 433. However, the Examiner is not arguing that the composition of the current claims is a thing in the prior art, merely that such a composition may be suggested by the prior art. Therefore, this rationale for the holding in *Obiaya* is not applicable to the current case. Moreover, the inherency rejection dealt with in *In Re Best* was to claims for a process, not to compositions as currently claimed.

The other precedent case, *In Re Wilder*, is more on point. *Wilder* deals with claims to a composition of matter. However, as stated in footnote 3 of the *Wilder* opinion,

"It will be apparent that we are treating the instant claims, concededly drawn to compositions, as if the only important element is the anti-oxidant adjuvant and the rubber merely acts as a matrix or environment wherein the important properties of the adjuvant compound are manifested. In this respect the claims may be said to be similar to those drawn to a pharmaceutical or insecticidal compositions similarly containing only a single "active" ingredient. It should be apparent that this approach cannot be utilized with all claims drawn to compositions." (emphasis added)

Since the current claims are to a composition that cannot be categorized as containing only a single "active" ingredient, the rationale of *In Re Wilder*, and by extension, *Obiaya*, does not hold to the current claims.

In view of the above arguments, the Applicants request that the Panel consider the following question. An axiom of patent law is that an obviousness rejection can be rebutted by a showing of unexpected results. However, under the Examiner's position, all properties of a new

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composition (that is rejected for obviousness) are inherent in that composition and any properties, even if unexpected, would be merely a newly discovered advantage flowing naturally from the suggestions in the prior art. Consequently, if the Examiner's argument holds, how could unexpected results ever be used to rebut an obviousness rejection?

Therefore, the Applicants believe that the prior remarks and arguments that have been presented provide evidence of unexpected results that rebut the Examiner's *prima facie* case and are not dismissible under the doctrine of *Wilder/Best/Obiaya*. As such, the Applicants maintain their previous arguments, which are summarized below.

The Applicants believe that the present invention exhibits surprising results in view of the prior art. In particular, the prior art would not lead one skilled in the art to expect the synergistic effects on melt viscosity and volume resistance achieved by using a blend of carbon nanotubes and carbon black. Also, the Applicants believe that the current invention demonstrates an unexpected long term stability in volume resistivity.

Table 1 on page 18 of the specification reports the viscosity for various compositions, and the viscosity of the Example 1 composition (all carbon black) is significantly higher at various shear rates than the viscosity of the Example 4 composition (mixture of carbon black and carbon nanotubes). The lower viscosity of Example 4 is important to a more facile in the processing of the composition into a semiconductor shield layer. This lower viscosity is even more striking when compared against the composition of Example 2 which contains 20 weight percent carbon nanotubes and 0 weight percent carbon black. The viscosity of the composition of Example 2 is even greater across the various shear rates than that of the composition of Example 1.

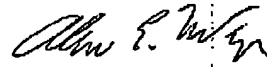
In addition, at page 20, Table 2 of the specification, the volume resistivities of the compositions of Examples 1-4 are reported. The Examiner will note that not only is the volume resistivity of the composition of Example 4 comparable to that of the composition of Example 1, but it is much more stable over various thermal cycles than the volume resistivity of the Example 1 composition.

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The Applicants believe that the claims are patentable for the reasons stated above. The Applicants therefore request that the Panel reconsider and withdraw the rejections and issue a Notice of Allowance.

Respectfully submitted,



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Dated: March 13, 2006

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